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EXAMINER

COMSTOCK, DAVID C

ART UNIT

PAPER NUMBER

3733

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Claim Objections

Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form. As previously noted, claim 5 depends from claim 4, which is a canceled claim. Applicant failed to correct this deficiency and the claim's proper dependency remains unclear. *Accordingly, claim 5 has been withdrawn from further consideration.*

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7 and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michelson (6,558,423; of record).

Michelson teaches an interbody fusion implant 800 having a height which is greater than the intervertebral spacing (see, e.g., Fig. 46D), such that when implanted, at least a portion of the device 800 penetrates into one or both of upper and lower vertebral bodies (see, e.g., Figs. 52 and 53). The implant includes a threaded fastener 842 configured to extend through the implant 800 and the vertebral body (see Figs. 52 and 53). The implant includes apertures 834 which receive the fastener 842, and a

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guide 836. It is clear that the implant includes lateral surfaces wherein the apertures 834 are located. Each of the lateral surfaces faces a vertebral body when implanted (see Figs. 46D, 52 and 53). Michelson does not explicitly disclose the removability of the guide, defined by the lateral surface and corresponding aperture. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the implant with removable guides, defined by the lateral surfaces and corresponding aperture, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Allowable Subject Matter

Claims 7 and 9-11 are allowed.

Response to Arguments

Applicant's arguments filed 26 September 2005 have been fully considered but they are not persuasive.

First and foremost, Applicant is encouraged to read 37 CFR 1.3 (MPEP 714.25) so that all future correspondence with the Office is proper and suitable for entry into the official record. Examiner has NOT inappropriately attempted to pass off his own words as those of Applicant (see Applicant's Remarks). Examiner's remarks were made in a non-final rejection to which Applicant could respond. If there are no arguments regarding a set of claims, and the case is still pending, Examiner is within his right

and duty to draw logical conclusions, which Applicant can appropriately rebut if necessary. Applicant asserts that Examiner stated “applicant agrees with the Examiner that Michelson ‘423 anticipates claims 1-3 and 5.” However, and rather importantly, Applicant omits that Examiner qualified the statement with “it appears that” (i.e. “*it appears that* Applicant agrees...”). Thus, examiner simply drew a logical conclusion about the status of the claims that Applicant can appropriately rebut. Thus, it is actually Applicant’s remarks that inappropriately mischaracterize those of the Examiner.

Applicant also attempts to argue that an aperture somehow cannot be considered a guide. However, for this argument to be given any weight, it is noted that the specification must clearly set forth the definition of “guide” explicitly and with reasonable clarity, deliberateness, and precision sufficient to preclude the noted interpretation. Exemplification is not an explicit definition. Even explicit definitions can be subject to varying interpretations. See *Teleflex, Inc. v. Ficosa North America Corp.*, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.*, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001), and MPEP 2111.01. Furthermore, it is noted that arguments of attorney cannot take the place of evidence. Moreover, Examiner interprets claim language under a broadest reasonable interpretation consistent with the specification. Certainly, an aperture can be considered to be a nebulously claimed “guide,” at least since an aperture has walls which bound and direct an object passing therethrough. That independent *claim 1 has been narrowed in its scope* by Applicant in the present amendment *to overcome the Michelson rejection under 35 USC 102(e)*, also suggests that an aperture can be reasonably considered a guide.

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Applicant has requested that Examiner explicitly point out where the '423 patent teaches or suggests " a fastener configured to extend through at least a portion of at least one of the vertebral bodies and into the lateral surface of the fusion device."

Apparently, Applicant has overlooked page 2 (the last two lines) of the Office Action mailed on 25 May 2005 where Examiner explicitly stated, "The implant includes a threaded fastener 842 configured to extend through the implant 800 and the vertebral body (see Figures 52 and 53)." If Applicant is unable to locate this passage or has any other questions, he is encouraged to call the Examiner at 571-272-4710 for assistance.

Respectfully,



D. Comstock
10 December 2005



EDUARDO C. ROBERT
PRIMARY EXAMINER